

**IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE**

Applicant(s):	Smith	Docket No.:	101.00013
Application No.:	10/673,901	Group Art Unit:	3663
Filing Date:	September 28, 2003	Examiner:	Greene
TITLE	Hand-Held Stun Gun For Incapacitating A Human Target		

**RESPONSE PURSUANT TO 37 C.F.R. §1.104(e)**

Mail Stop: Issue Fee  
Commissioner for Patents  
Washington, DC 20231

Commissioner:

Applicant respectfully disagrees with the Examiner's statements of reasons for allowance provided in the prosecution history of this case. Applicant does not acquiesce in any statement or position taken by the Examiner as to allowance of the claims. The provided statements are incomplete and as such may give rise to reasoning that is inconsistent with the proper scope of the claims. The statements do not include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentability over the prior art.

Applicant disagrees that any limitation can be identified as a "major difference" because, *inter alia*, claim construction requires each claim to be taken as a whole. Patentability of each claim is imparted by each claim as a whole. No portion of any claim is to be construed as more important for patentability than any other portion. The combination of limitations recited in each claim is patentable subject matter whether or not identified as such by the Examiner.

Applicant asserts that each claim is allowable because all statutory requirements have been met, including, *inter alia*, the absence, in all art of record, of the same invention as claimed or any disclosure, teaching, or suggestion (explicit or implied) that would make the claimed invention obvious to a person having ordinary skill in the art. The Examiner's statements are incomplete because they do not address this absence as to each cited reference as one of the bases for allowance.

The Examiner's statements cannot be properly construed as stating all reasons for allowance nor a sole reason for patentability. It is not mandatory that the Examiner set forth reasons for allowance. It is not mandatory that a "major or important reason" be identified. The direction given in the regulation is permissive: "the examiner *may* set forth such reasoning" 37 CFR 1.104; and the direction in the MPEP is permissive: "it *may* suffice to state only the major or important reasons, being careful to so couch the statement." MPEP 1302.14 8th Edition Rev. 2, page 1300-15. (Emphasis added). Consequently, the Examiner's stated reasons may be other than major and other than important. Applicant does not acquiesce that the Examiner's stated reasons are either major or important.

Applicant has made numerous bases for allowance and the Examiner's statements of reasons for allowance do not identify one or more of these as persuasive or unpersuasive. Differences between the cited art and the claimed invention are numerous. Some of the differences may not appear of record. Applicant does not intend any inferences to be drawn from differences that are not of record, because, *inter alia*, some differences may have been understood from a review of the prior art and the claimed invention at the time.

The Examiner's statements of reasons for allowance do not present a cogent argument and Applicant's arguments of record are neither misdirected nor unpersuasive taken separately.

Failure of the Examiner to mention any particular information in the provided statements of reasons for allowance does not raise any implication as to whether such particular information was relied upon or not.

The Examiner has not completely collected in the provided statements all reasons for allowance that may appear elsewhere in the prosecution of this case or related cases known to the Examiner at the time the statements were prepared. All subject matter in each cited reference

was considered by the Examiner as material to examination whether or not discussed in the Examiner's reasons for allowance.

Applicant does not acquiesce in any statement or position taken by the Examiner that has become moot, including separate rejections of dependent claims when the parent claim is deemed allowable or indicated to contain allowable subject matter. No implication may be drawn from absence from the record of a complete counter argument by Applicant for traversing rejection of a dependent claim when the parent claim is deemed allowable because such argument may merely form one of several cumulative alternate arguments for patentability.

No implication as to what subject matter that may have been relinquished or the reason for relinquishing may be drawn from the Examiner's statements of reasons for allowance, *inter alia*, because the Examiner's statements are incomplete as discussed above.

The scope of the allowed claims is readily apparent to a person of ordinary skill in the art from, *inter alia*, the application, the claims, the prosecution history, and the cited references without reliance in any way on the Examiner's statement of reasons for allowance.

Respectfully submitted,

3/31/06

Date

By



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